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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,358	03/16/2004	Richard Jupe	04981-00493-US	2100
23416 7590 03/21/2008 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
LOPEZ, CARLOS N				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
03/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,358

Applicant(s)

JUPE ET AL.

Examiner

Carlos Lopez

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-48 and 50-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44, 45, 47 and 55 is/are rejected.
- 7) ☒ Claim(s) 46, 48, 50-54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/07 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44, 45, 47 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry et al (US. 5,568,819) in view of Lebet et al (US 4,412,829) and Hall (US 4,425,107). Gentry discloses a multi-component cigarette filter (30) comprised of a first segment adsorbent section 70 and filter second segment section 72. Section 70 is formed of paper having carbonaceous material or paper (See Col. 4, lines 55ff). Paper is essential a mass of wood fiber as such it is deemed as reading on the claimed limitation of "adsorbent particles" wherein the particles are the actual wood fibers massed to form a paper web that is deemed as the claimed "bed". The word "bed" is merely being interpreted as a heap or agglomeration of mass.

The second segment as noted in col. 5, lines 25ff is made of filtering material, which Gentry at Col. 10, lines 1ff further teaches of having flavoring agents. Consequently the claimed flavor-releasing component is Gentry's second segment having flavorants.

The limitation regarding the ventilation is depicted by element 50 in figure 5 and described in Col. 4, lines 44ff.

As noted in Col. 2, lines 29ff, the absorbent material of Gentry is made of paper impregnated with absorbent filtering material. Consequently, Gentry does not use chambers filled with granules as the absorbent means. However, filter segments comprising chambers filled with granules as filtering means are already known in the art. Lebet teaches the person of ordinary skill in the art that providing chambers (14) filled with pourable filter material may be used filter segments (Col. 1: lines 6-45). While Lebet does not further specify the type of pourable filter material, Hall teaches us that it may be a granular adsorbent material such as granular charcoal (Col. 2: lines 8; Col. 3: lines 25ff). Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to have used known filter segments such as filled chamber comprising granular material as taught by Lebet and Hall as alternate means for making cigarette filters.

Moreover, it has been held that "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product of not innovation but of ordinary skill and

common sense." KSR International Co. v. Teleflex Inc., 550 U.S. 820 USPQ2d 1385 (2007).

In the instant case, filter segments comprised of filled granular absorbents are shown to be known in the art as taught by Lebet and Hall. Consequently its use in modifying Gentry would have been with the grasp of a person of ordinary skill in the art and thus not a product of innovation but of ordinary skill and common sense.

In regards to the limitation that the chamber be filled at least 85%, Lebet teaches that the chamber are at least partially filled (Col. 1: lines 51), hence it the filling of the chamber may reach up 100%.

As for claim 45, Col. 15, lines 50ff the carbon containing paper is activated carbon which in combination with the teaching noted in Col. 10, line 1ff of having the filter material with flavoring agent, the claimed invention of having a adsorbent particles including flavorant-bearing activated carbon is arrived.

As for claim 47, second segment 72 is cellulose acetate as noted in Col. 5, lines 35ff in combination with the teaching noted in Col. 10, line 1ff of having the filter material with flavoring agent, the claimed invention of having cellulose acetate with flavorant thereon is arrived.

As for claim 55, the amount of carbon claimed is disclosed in Col. 8, lines 1ff of Gentry wherein the claimed filled segments are at least fully filled as shown in the figures of Gentry.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 44 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 11/346429 ('429) in view of Keitsis (US 5,115,823). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of '429 discloses a cigarette comprising a tobacco rod and a multi-component filter. The filter comprises of a bed of sorbent particles and a flavoring releasing component located downstream the sorbent particles wherein the cavity holding the adsorbent particles is at least 85% filled. Claim 2 of '429 further notes of that the sorbent particles are activated carbon. While '429 does not disclose that the activated carbon is adsorbent to mainstream cigarette smoke, it would be obvious to a person of ordinary skill in the art

at the time the invention was made that activated carbon are or capable of being adsorbent to mainstream cigarette smoke.

Claim 2 of '429 is silent disclosing the use of ventilation at the upstream portion of the flavor-releasing component that is adjacent to the adsorbent component. However, Keritis teaches of providing ventilation holes at the upstream portion of a flavorant section/component in order to improve flow characteristic of the smoke being inhaled in so that the smoke can absorb more flavorants (Col. 4, lines 1ff). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have provided ventilation perforations at the upstream section of the flavor component of '429 as taught by Keritis in order to allow for the smoke being inhaled to absorb more flavorants .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 46, 48, and 50-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 44, 45, 47, and 55 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Carlos Lopez
Primary Examiner
Art Unit 1791

/ Carlos Lopez/
Primary Examiner, Art Unit 1791

